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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,322	08/02/2001	Keunsuk P. Chang	1151-01	5050

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IP DEPARTMENT OF PIPER RUDNICK LLP
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EXAMINER

JACKSON, MONIQUE R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/921,322

Applicant(s)

CHANG ET AL.

Examiner

Monique R Jackson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See attached.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-44.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Continuation of Item No. 3. NOTE: The Applicant's arguments filed 9/8/03 have overcome the rejections based on Nagai et al in view of Ristey et al as recited in paragraphs 5-7 of the prior office action, wherein the Examiner agrees that one skilled in the art would not have been motivated to look to the teachings of Ristey et al in terms of Young's Modulus, elongation and tensile strength in producing the film taught by Nagai et al.

Continuation of Item No. 5. NOTE: The Applicant's arguments filed 9/8/03 have been considered but are not persuasive with regards to the rejection over Ristey et al in view of Nagai et al. It is first noted that the Applicant argues that the instant invention is a non-shrinkable film while the film of Ristey et al is shrinkable and additionally argues other properties of the instant invention that are not recited in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-shrinkable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Applicant also argues that one skilled in the art would not provide a metallized layer as taught by Nagai et al on the film taught by Ristey et al because attempts to metallize such a heat shrinkable film would essentially fail. However, it is noted that the Nagai et al reference was only utilized as a supporting document to support the Examiner's position that the thickness of the layers and the optical density of the metallized layer are result-effective variables wherein one skilled in the art would have been motivated to determine the optimum thickness based on the desired barrier properties wherein the invention taught by Nagai et al is directed to a barrier packaging film

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having similar thickness values as instantly claimed. Nagai et al was further relied upon to support the Examiner's position that the additives as instantly claimed are conventional in the packaging industry and hence one skilled in the art would have been motivated to select any conventional additive utilized in the art. The invention taught by Nagai et al was not utilized to teach metallization of the film taught by Ristey et al given that Ristey et al clearly disclosed metallization within itself (Col. 36, lines 40-53) and hence Applicant's arguments that one skilled in the art would not be motivated by Nagai et al to metallize the film taught by Ristey et al are moot given that Ristey et al alone teach that their film(s) may be metallized. In terms of the process limitations argued by the Applicant, i.e. vapor metallization temperature, it is noted that the instant invention does not recite these process limitations, and further is directed to a product not a process.

Lastly, the Examiner acknowledges Applicant's request to withdraw finality of the prior office action given that the prior amendments were made to overcome rejections based on 35 U.S.C. §112. However, the Examiner notes that though the prior amendments were made with respect to matters of form and overcoming the indefiniteness rejections, they did necessitate the new grounds of rejection given that the claims were amended to positively recite limitations with respect to Young's modulus, elongation and tensile strength that were not previous requirements of the claimed invention given that they were not positively recited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


MONIQUE R. JACKSON
PRIMARY EXAMINER

Technology Center 1700
September 21, 2003